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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/688,441	10/17/2003	Samuel B. Osae	P-1086 C	1558

7590 07/26/2005

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EXAMINER

NUTTER, NATHAN M

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 07/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/688,441

Applicant(s)

OSAE ET AL.

Examiner

Nathan M. Nutter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1203, 0404</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Specification

The disclosure is objected to because of the following informalities: the parent applications have passed into issues patents. The Specification must be amended at page 1 (lines 10-12) to reflect the status of each of these applications.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 7-9 are 13-16 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Each of claims 7-9 recite that the “thermoplastic or partially thermoplastic polymer or elastomer is selected from the group consisting of a nitrile elastomer, a liquid nitrile polymer, ***a polymer or copolymer of chloroprene, acrylonitrile, styrene, butadiene, isoprene, ethylene, propylene, epichlorohydrine, an acrylate or methacrylate monomer***, a chlorinated polymer....” The recitation in bold italic lettering is not clear since the “thermoplastic or partially thermoplastic polymer or elastomer” is not monomeric. The same confusion exists for claims 13 and 15 in the recitation that “the thermoplastic polymer is selected from the group consisting of polystyrene, ***acrylic, styrene/acrylic, styrene/acrylonitrile***, ABS, MABS, and polyvinyl chloride and mixtures thereof.” The monomers “acrylic, styrene/acrylic, styrene/acrylonitrile” do not

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suffice to define thermoplastic polymers without further connotation. The recitation in claims 14 and 16 "wherein the elastomer or mixture of elastomers is selected from the group consisting of soluble or lightly crosslinked polychloroprene, chlorinated polyethylene, chlorosulfonated polyethylene, **epichlorohydrine, polymers co-polymers**, styrene-butadiene and styrene-isoprene polymers and block copolymers, soluble, lightly crosslinked or liquid **polymers of acrylonitrile, butadiene and isoprene, acrylic, ethylene acrylic elastomers**, and mixtures thereof," is vague and confusing since epichlorohydrine is monomeric and it cannot be ascertained what the "crosslinked or liquid polymers" may comprise as far as monomers since ethylene acrylic elastomers are not monomeric.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-25 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-24 of U.S. Patent No.

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6,602,958, Briggs et al, newly cited. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instantly claimed invention broadly embraces the concepts of the patented claims in composition and constitutional limitations.

Claims 1-25 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-36 of U.S. Patent No.

6,852,801, Briggs et al, newly cited. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instantly claimed invention broadly embraces the concepts of the patented claims in composition and constitutional limitations.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-6, 10-16, 18-23 and 25 are rejected under 35 U.S.C. 102(e) as being anticipated by Cheng (U.S. Patent No. 6,291,593), cited by applicants.

The reference to Cheng (U.S. Patent No. 6,291,593), teaches the manufacture of an adhesive composition having a "thermoplastic or partially thermoplastic polymer or elastomer....an unsaturated polyester resin or vinyl ester resin, and....an alkyl acrylate or methacrylate monomer," as recited and claimed herein. Note the Abstract, the table at columns 2 and 3 for the broad concept. Note column 3 (lines 11-45) for the specific acids employed at claims 18-20, and the use of chlorosulfonated polyethylene. Note column 4 (lines 1-18) for the use of core-shell graft copolymers. Note column 4 (lines 27-55) and the paragraph bridging column 4 to column 5 for the use of additives including hydroperoxides and aromatic amines (claim 25). Note the Table in column 6. Finally, note the claims. The compositional limitations for all constituents, as recited in the instant claims, are embraced by those disclosed and taught by the reference.

Claims 1-6, 10-16, 18-23 and 25 are rejected under 35 U.S.C. 102(e) as being anticipated by Cheng (U.S. Patent No. 6,433,091), cited by applicants.

The reference to Cheng (U.S. Patent No. 6,433,091) teaches the manufacture of an adhesive composition having a "thermoplastic or partially thermoplastic polymer or elastomer....an unsaturated polyester resin or vinyl ester resin, and....an alkyl acrylate or methacrylate monomer," as recited and claimed herein. Note the Abstract, column 1 (lines 30-42) and the table at column 2 (lines 6-30) for the broad concept. Note column 2 (lines 42-54) for the specific acids employed at claims 18-20. Note the paragraph bridging column 2 to column 3 for the use of chlorinated polyethylene, as recited in

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claim 15. Note column 3 (lines 26-50) for the use of core-shell graft copolymers, including those as recited in claims 4, 6, 12, 15 and 18. Note column 3 (line 55) to column 4 (line 19) for the use of additives including hydroperoxides and aromatic amines (claim 25). Finally, note the claims which teach essentially what is claimed, especially in reference to instant claims 5, 6, 11 and 15. The compositional limitations for all constituents, as recited in the instant claims, are embraced by those disclosed and taught by the reference.

Claims 1-5, 7-13, 15-20 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Gosiewski et al (U.S. Patent 5,945,461), newly cited.

The reference to Gosiewski et al (U.S. Patent 5,945,461) teaches the manufacture of an adhesive composition having a "thermoplastic or partially thermoplastic polymer or elastomer....an unsaturated polyester resin or vinyl ester resin, and....an alkyl acrylate or methacrylate monomer," as recited and claimed herein. Note column 5 (lines 1-13), the Abstract and column 1 (line 50) to column 2 (line 6) for the broad concept, including the compositional limitations as recited herein for claims 1-3. Note column 2 (lines 9-22) for the methacrylate ester monomers employed, as recited in claim 20. Note the inclusion thereof at (lines 23-26). The use of maleic acid is shown at column 2 (lines 27-32), as recited in claims 18 and 19. Note column 2 (lines 40-64) for the resins of claims 5, 7, 11 and 13. Note column 3 (lines 25-66) for the core-shell copolymers employed in claims 4 and 12. Other additives, as recited in claim 23, are shown at column 4 (lines 38-47). Finally, note the patent claims.

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Claims 1-5, 7-13, 15, 16, 18-20 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Gosiewski et al (U.S. Patent 5,206,288), cited by applicant.

The reference to Gosiewski et al (U.S. Patent 5,206,288) teaches the manufacture of an adhesive composition having a "thermoplastic or partially thermoplastic polymer or elastomer....an unsaturated polyester resin or vinyl ester resin, and....an alkyl acrylate or methacrylate monomer," as recited and claimed herein. Note column 2 (lines 56-63), column 3 (line 30) to column 4 (line 19) for the broad concept, including the compositional limitations as recited herein for claims 1-3, the methacrylate ester monomers employed, as recited in claim 10, and the organic acid, including acrylic acid and maleic acid, as recited in claims 18-20. Note column 3 (lines 42-67) for the resins of claims 5, 7, 8, 11, 13 and 17. Note column 4 (lines 32 et seq.) for the core-shell copolymers employed in claims 4 and 12. Mixtures of polymers, as recited in claim 9, are shown at column 4 (lines 21-31). Other additives, as recited in claim 23, are shown at column 5 (lines 29-65). Finally, note the patent claims.

Claims 1-5, 7-10, 12, 14, 18, 19 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Briggs (U.S. Patent 4,773,957), newly cited.

The reference to Briggs (U.S. Patent 4,773,957) teaches the manufacture of an adhesive composition having a "thermoplastic or partially thermoplastic polymer or elastomer....an unsaturated polyester resin or vinyl ester resin, and....an alkyl acrylate or methacrylate monomer," as recited and claimed herein. Note the Abstract, column 11 (line 44) to column 12 (line 34), column 3 (line 67) to column 4 (line 11) and column 4

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(lines 27-59) for the broad concept, including the compositional limitations as recited herein for claims 1-3, the methacrylate ester monomers employed, as recited in claim 10, the organic acid, including acrylic acid and maleic acid, as recited in claims 18-20, and the use of other additives, including hydroperoxides as recited in claim 23. Note column 8 (lines 4-45) for the core-shell copolymers employed in claims 4 and 12. Mixtures of polymers, as recited in claim 9, are shown at column 4 (lines 53-59).

Claims 1-5, 7, 8, 10, 12, 13, 18-20 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Briggs et al (U.S. Patent 4,942,201), newly cited.

The reference to Briggs et al (U.S. Patent 4,942,201) teaches the manufacture of an adhesive composition having a "thermoplastic or partially thermoplastic polymer or elastomer....an unsaturated polyester resin or vinyl ester resin, and....an alkyl acrylate or methacrylate monomer," as recited and claimed herein. Note the Abstract and the paragraph bridging column 4 to column 5 for the broad concept including the compositional limitations as recited herein for claims 1-3. Note column 2 (lines 11-18) for the methacrylate ester monomers employed, as recited in claim 10, column 2 (lines 23-29) for the use of an organic acid, including acrylic acid and maleic acid, as recited in claims 18-20, and column 2 (lines 36-64) for the recitations of claims 5, 7, 8 and 13. Note column 4 (lines 33 et seq.) for the use of other additives, including hydroperoxides as recited in claim 23. Note column 3 (lines 21 et seq.) for the core-shell copolymers employed in claims 4 and 12.

Claims 1-3, 5, 7, 10, 13, 18-21 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Zalucha et al (US Patent 4,293,665), cited by applicants.

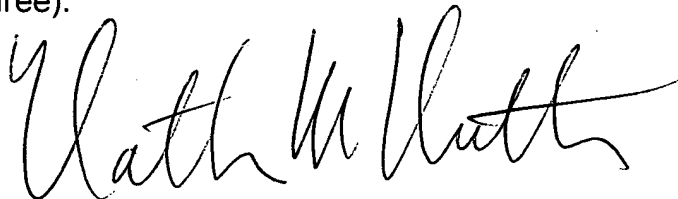
The reference to Zalucha et al (US Patent 4,293,665) teaches the manufacture of an adhesive composition having a "thermoplastic or partially thermoplastic polymer or elastomer....an unsaturated polyester resin or vinyl ester resin, and....an alkyl acrylate or methacrylate monomer," as recited and claimed herein. Note the Abstract and column 5 (line 60) to column 6 (line 28) for the broad concept including the compositional limitations as recited herein for claims 1-3, 13 and 7 for the methacrylate ester monomers employed, as recited in claim 10, column 6 (line 5) for the use of an organic acid, including methacrylic acid, as recited in claims 18 and 19, and column 6 (lines 6-13) for the use of blends as recited in claim 5. Note column 7 (lines 18-23) for the use of maleic acid, as recited in claim 20. Note column 7 (lines 53 et seq.) for the use of a phosphate ester, as recited in claim 21.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan M. Nutter whose telephone number is 571-272-1076. The examiner can normally be reached on 9:30 a.m.-6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James J. Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Nathan M. Nutter", with a stylized, cursive script.

Nathan M. Nutter
Primary Examiner
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nmn

22 July 2005